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CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Vincent's of Mott Street, Inc. and Vincent Generoso
v.
Quadami, Inc.

Opposition No. 97,805
to Application Nos. 74/358,685 and 74/358,686
filed on February 11, 1993

Richard J. Magid of Whiteford, Taylor & Preston for
Vincent's of Mott Street, Inc. and Vincent Generoso.

Jonathan E. Moskin of Pennie & Edmonds and Lee D.
Unterman and Patricia Moore of Kurzman, Karelsen & Frank
for Quadami, Inc.

Before Simms, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Vincent's of Mott Street, Inc. and Vincent Generoso
filed their opposition to two applications of Quadami,

Inc. to register the marks shown below for "restaurant services" in International Class 42.



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As grounds for opposition, opposers assert that applicant's marks, when applied to applicant's services so resemble opposers' previously used marks for restaurant services as to be likely to cause confusion,

¹ Application Serial No. 74/358,685, filed February 11, 1993, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of July 21, 1992. The application includes a disclaimer of ORIGINAL and ESTABLISHED 1904 apart from the mark as a whole.

² Application Serial No. 74/358,686, filed February 11, 1993, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of July 21, 1992, which dates were changed by amendment to March 28, 1993. Because the dates of use were changed to a date subsequent to the filing date, should applicant ultimately succeed in this opposition, this application shall be remanded to the Examining Attorney for amendment either to the dates of use or to the basis for registration. The application includes a disclaimer of FROM LITTLE ITALY TO LONG ISLAND, CLAM BAR, NYC MOTT ST. and NYC HESTER ST. apart from the mark as a whole.

under Section 2(d) of the Trademark Act. Specifically, opposers allege prior use of the mark "THE ORIGINAL VINCENT'S," and marks adding to this mark, variously, "ESTABLISHED 1904," "FROM LITTLE ITALY" and/or "IN LITTLE ITALY," and the designs shown *infra*.

Applicant, in its answer, denied the salient allegations of the claim and asserted as affirmative defenses: estoppel, acquiescence, unclean hands, that opposer's use of the marks has inured to applicant's benefit, abandonment, and, further, that any use by opposer is limited to a single restaurant.

The Record

The record consists of the pleadings; the files of the involved applications; various specified responses of opposers to applicant's interrogatories, made of record by applicant's notice of reliance; the testimony deposition by applicant of Anthony Marisi, applicant's president, with accompanying exhibits; the discovery deposition of Anthony Marisi with exhibits, made of record by opposers' notice of reliance; and the testimony depositions by opposers of opposer Vincent Generoso with accompanying exhibits, and Santiago Marcial, a restaurant employee of opposers. Both parties filed briefs on the case and an oral hearing was held.

Before we begin a recitation of the facts established in the record, we emphasize that the nature of our inquiry is limited to determining whether applicant is entitled to registration of the marks for the recited services in the two applications.³ The questions of opposers' rights in the pleaded marks, applicant's ownership of its marks and priority are key to resolving this opposition.

The Factual Record

Opposers, the owners and operators of a restaurant located at 119 Mott Street in New York City, and applicant, the owner of a restaurant located in Carle Place, Long Island, New York, both owe the genesis of their respective businesses to the same restaurant.

There is no dispute that the original restaurant, "Vincent's Clam Bar," was started by members of the Siano family in 1904 at 119 Mott Street in New York City and was subsequently owned by various third parties; that, until 1979, this restaurant was operated by the Siano family and owned by members of the Siano family and/or corporate interests controlled by members of the Siano family; and that the Siano family and/or their corporate

³ We are not determining the respective rights of the parties to use certain marks, nor can we enforce such rights or enforce other agreements or court orders.

interests owned and operated only the single restaurant at 119 Mott Street ("the Mott Street restaurant").

There is also no dispute that Andrew DeLillo was involved, either in his individual capacity or as principal of a corporation, in the purchase of the Mott Street restaurant from the Sianos; that he was involved in the business of the restaurant until it was sold under a 1985 bankruptcy stipulation; that during his involvement in the Mott Street restaurant and prior to the bankruptcy stipulation, he or his corporate interests opened, outside of Manhattan, several additional restaurants under the name Vincent's Clam Bar and started a business making and selling sauces; and that one of the Vincent's Clam Bar restaurants Mr. DeLillo or his corporate interests opened is in Carle Place, New York ("the Carle Place restaurant"), and it is presently owned by applicant.

The record shows that numerous individuals and corporate entities have been involved with applicant's business; that the chains of title of the restaurants and marks in this case are not entirely clear; and that certain important facts cannot be established from this

record. However, we shall recite the facts as we find them to be from the record before us.

Opposers

We begin with the evidence establishing facts pertaining to opposers. The record shows that opposer Vincent Generoso has been, since 1987, president and sole director and officer of opposer Vincent's of Mott Street, Inc., which was incorporated on July 26, 1985⁴; that Vincent Generoso was one of the group of individuals that purchased the Mott Street restaurant through a bankruptcy stipulation in 1985; and that, since the 1985 purchase, Mr. Generoso has continued to operate and manage the Mott Street restaurant.

Opposers state that they are both owners of the Mott Street restaurant. They state, further, that they derive their ownership of, and interest in, the Mott Street restaurant from a Chapter 11 proceeding before the Bankruptcy Court for the Southern District of New York, which was filed on April 25, 1985, and concluded by a

⁴ The record establishes that Vincent Generoso and Joseph Maggiore were equal shareholders in the corporation; that Mr. Maggiore died and, in June 1987, Mr. Generoso purchased the remaining shares from Mr. Maggiore's estate.

"Stipulation" entered by the court on October 29, 1985.⁵
This proceeding is also relevant to applicant's rights,
as we discuss *infra*.

The Mott Street restaurant, and property related thereto, is the asset that was the subject of the bankruptcy proceeding. The debtor in the bankruptcy proceeding is identified as Mott & Hester Restaurant Corp. and Mott & Hester Restaurant Corp., d/b/a Vincent's Clam Bar ("Mott & Hester"). The stipulation states that Irving Burstein,

⁵ An additional proceeding involving the debtor in this proceeding was resolved by the stipulation as well. However, we do not discuss it herein because it is not relevant to this opposition.

Vincent Generoso, Michael Generoso, Joseph Maggiore, Marie Graziano and Richard Panebianco ("purchasers") "have offered to purchase the premises known as 119 Mott and Hester Streets, New York, N.Y., none of whom is affiliated in any way with Mott & Hester or any other party herein." The stipulation includes, in pertinent part, the following additional statements:

1.D.

... purchasers do not and will not have, nor represent itself to have, any affiliations or connection with any other business known as "Vincent's Clam Bar," "Vincent's Clam Bar of Mott and Hester Streets," or "Mott and Hester Restaurant," or any facsimile thereof, and will remove any reference thereof from menus, signs, ... and ... **purchasers further agree that they will not, in any way, represent that they are affiliated with any other business licensee or franchisee using said name or names or facsimile thereof and that they shall use and operate their business at the aforementioned premises [119 Mott Street] under the name of "Vincent's Clam Bar," and/or "Vincent's Clam Bar of Mott and Hester Streets," or "Mott and Hester Restaurant," and only at said location without limitation of time and at no other location,** and Mott & Hester and Andrew DeLillo agree to execute an assignable covenant not to compete within a ten-block radius of the premises for the length of the mortgage referred to hereinabove, at the closing, in favor of ... purchasers, and the parties hereby agree that ... purchasers are not successors in interest, licensees, franchisees and/or affiliated with Mott & Hester ... [*emphasis added*]

1.E.

... purchasers acknowledge and agree, **subject to the terms of paragraph "1.D." herein, that**

Andrew DeLillo is the sole owner of and has the sole and exclusive right to use the name, trademark and copyrights in and to the names "Vincent's Clam Bar," "Vincent's Clam Bar of Mott and Hester Streets," or "Mott and Hester Restaurant," and nothing contained herein shall be deemed a sale thereof nor shall in any way restrict or interfere with said right and interest or his right to use, convey, sell, license, franchise or in any other way dispose of or make use of said names ... [emphasis added]

The record is silent on the factual question of how ownership of the Mott Street restaurant passed from the individuals listed in the bankruptcy stipulation to opposers. However, the documentary evidence submitted with Mr. Generoso's testimony supports opposer corporation's involvement in the restaurant since at least 1986; includes a corporate certificate of assumed name for "Vincent's," listing the corporate address as 119 Mott Street; and supports Mr. Generoso's involvement in opposer corporation and the restaurant from the date of the bankruptcy stipulation. Further, applicant does not contest opposers' ownership of the Mott Street restaurant, as distinct from the marks. Thus, we find sufficient evidence to conclude that opposers have ownership interests in the restaurant; that they take their ownership of the Mott Street restaurant from the original individual purchasers recited in the bankruptcy

stipulation; and, thus, that opposers are bound by that stipulation which bound their predecessors.

Mr. Generoso stated that shortly after taking over the Mott Street restaurant, in November 1985, opposers changed the name on the outside of the restaurant to "Vincent's" and added "The Original," "Established 1904" and "From Little Italy" to distinguish the Mott Street restaurant from the Carle Place restaurant, with which opposers have no affiliation; and opposers also began advertising the restaurant, *inter alia*, in flyers and magazines in 1986, using "The Original Vincent's Clam Bar," adding, variously, "Established 1904" and "From Little Italy." Mr. Generoso stated emphatically that no one (including anyone with any connection to the Mott Street restaurant or the Carle Place restaurant prior to the bankruptcy stipulation) used the mark "The Original Vincent's Established 1904," and that opposers were the first to use this mark. Mr. Generoso stated, and the evidence supports, that opposers changed their restaurant signage to "Vincent's" almost immediately, in 1985-1986, and that the signage included the phrase either "Since 1904" or "Established 1904." Opposers' advertisements, beginning in 1986, show use of the mark "The Original Vincent's Clam Bar" and sometimes included the phrase

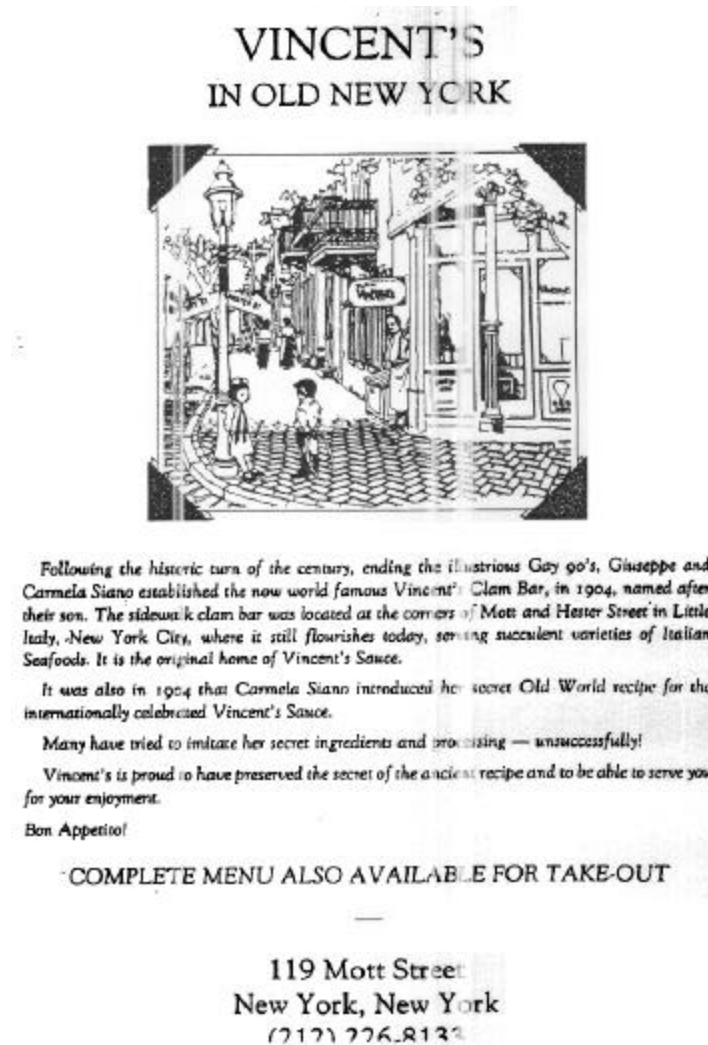
"Established 1904." It appears that during the period from 1985-1986 to 1989, opposers used "Vincent's Clam Bar," "The Original Vincent's Clam Bar," and "Vincent's," and they also added "Established 1904" at times to each of these marks; and that, in 1989, opposers dropped the term "Clam Bar" entirely from their name and marks.

However, Mr. Generoso acknowledged that, as shown below as used by opposers, the street sign design, the phrase "From Little Italy" and the scripts in which "From Little Italy" and "Vincent's" appear were in use in connection with the Mott Street restaurant by the Sianos prior to opposers' ownership of the restaurant.

Opposers' 1985-1986 menu includes uses of both "Vincent's" and "Vincent's Clam Bar" to identify the Mott Street restaurant. The following is the logo appearing on the cover of opposers' restaurant menu in 1985-1986:



The record shows that the above design with the street sign was used by opposers at least through 1989, but there is nothing in the record indicating that opposers have continued to use the street sign design. The following is a page from that same 1985-1986 menu⁶:

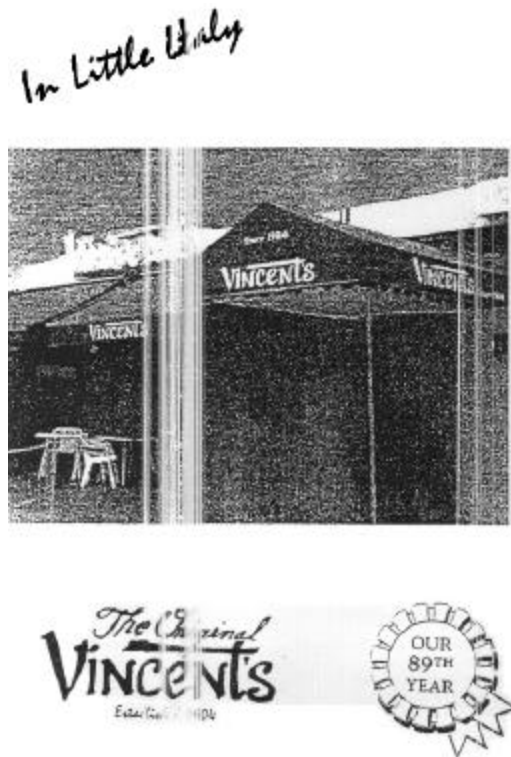


Mr. Generoso stated that the picture shown above was derived from an old photograph of the Mott Street

⁶ Although not apparent in this reproduction, the sign on the restaurant includes the wording "Vincent's Clam Bar" and the street sign names are "Mott Street" and "Hester Street."

restaurant that was given to him by Mr. Siano, of the restaurant's founding family, who initially advised Mr. Generoso and Mr. Maggiore in connection with opening and operating the restaurant. This picture appears in the record on a 1994 menu, but not on a 1996 menu, where a current photograph of the restaurant replaces the drawing immediately above the same text. It is not clear from the record whether opposers continue to use this picture.

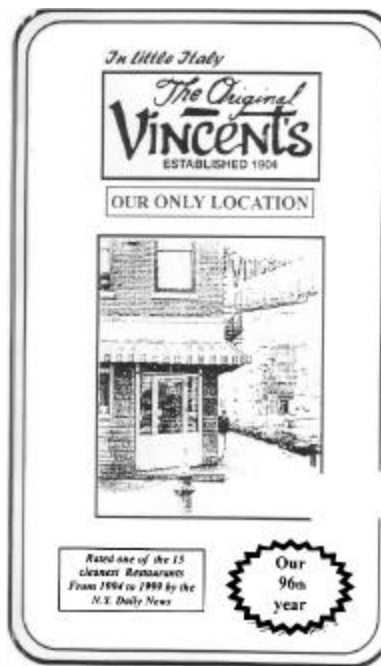
In 1989, Mr. Generoso renovated the restaurant. The following menu cover, from 1994, shows the exterior of the restaurant as it has appeared since that renovation⁷:



⁷ The wording above "Vincent's" on the awning is "Since 1904."

Also in 1989, opposers changed the phrase "From Little Italy" to "In Little Italy" on their menus and advertising to further distinguish their restaurant from the Carle Place restaurant. In 1994, opposers added "Our Only Location" to again further distinguish their restaurant.

The following is a copy of opposers' menu cover from 1996, showing the cumulative changes:



The following is a copy of opposers' current business card, which shows the same logo and writing as have appeared in its advertisements since at least 1989:



Mr. Generoso stated that there have been numerous instances⁸ where his patrons have reported believing that the Carle Place restaurant was owned by opposers and complaining that the food at the Carle Place restaurant was not as good as the food at the Mott Street restaurant. Mr. Generoso stated unequivocally that, other than the bankruptcy stipulation, opposers have never discussed or concluded a license or any other agreement concerning trademarks or restaurant operation with any of the DeLillos, their corporate interests, or applicant; that Mr. Generoso has met Mr. DeLillo only at the closing for the purchase of the Mott Street restaurant; and that Mr. Generoso has never met Robert or Anthony Marisi or any representative of applicant except in connection with this proceeding.

⁸ Mr. Generoso had no specific examples or number of complaints in this regard.

Applicant

Mr. Generoso stated that, through the bankruptcy stipulation, he and his partners purchased the building at 119 Mott Street from Vincent DeLillo; although it was also his understanding that Andrew DeLillo or "one of his corporations" owned the Mott Street restaurant, an ongoing business, at the time of the bankruptcy proceeding that transferred ownership thereof to Mr. Generoso and his partners; and that Mr. DeLillo or one of his corporations opened the Carle Place restaurant while owning and operating the Mott Street restaurant.

The documentary record begins with an agreement, dated September 29, 1979, for the sale of the Mott Street restaurant, along with the "use of the name 'Vincent's Clam Bar'" ("the 1979 sale"). The 1979 sale was from Vincent's Clam Bar, Inc., of which Joseph Siano was president, to Andrew DeLillo.⁹ There are no further references in the documentary record to the corporate entity named Vincent's Clam Bar, Inc.

Both opposer Vincent Generoso and applicant's president, Anthony Marisi, acknowledge in their testimony

⁹ The record establishes that there is an Andrew DeLillo, Sr. and an Andrew DeLillo, Jr., although the name "Andrew DeLillo" often appears in the documentary and testimonial record without the "Jr." or "Sr." distinction. The name is used in this decision as it appears in the relevant evidence.

that, after the 1979 sale, the restaurant, "Vincent's Clam Bar," continued to operate at 119 Mott Street, and that several other restaurants in other locations were operated under the name "Vincent's Clam Bar."¹⁰

The next change of ownership reflected in the record is pursuant to the 1985 bankruptcy stipulation discussed *supra*. The corporation that is the debtor in the bankruptcy proceeding is none of the previously mentioned individuals or corporations; rather, it is another corporation, Mott & Hester Restaurant Corp. and Mott & Hester Restaurant Corp., d/b/a Vincent's Clam Bar ("Mott & Hester").

The documentary record includes a 1980 franchise agreement for a restaurant named "Vincent's Clam Bar" in Carle Place, New York ("the Carle Place restaurant"), between Vincent's Clam Bar of Mott & Hester Streets, Inc.,¹¹ as franchisor, and Brinlaw, Inc., as franchisee.

¹⁰ There is evidence about recipes, menu items and Mr. DeLillo's food manufacturing business, which uses certain specified names on sauces. However, we do not discuss this evidence because it is not probative of the issues before us. Even if we were to consider the names used on the sauces, it would not affect our findings with respect to the ownership of trademarks used in connection with the pleaded restaurant services.

¹¹ An undated and incomplete copy of a document submitted by applicant states that Joseph Siano owns 100% of the stock in this corporation and transfers that stock to Vincent DeLillo and Andrew DeLillo, Jr. The franchise agreements referenced herein are signed on behalf of the corporate franchisor by Andrew DeLillo as president.

The record also includes two agreements dated March 15, 1983, whereby Brinlaw, Inc. sells its Carle Place restaurant to applicant, and the corporate franchisor grants a franchise to applicant for the Carle Place restaurant, including the right to use the name "Vincent's Clam Bar."

This corporation, Vincent's Clam Bar of Mott & Hester Streets, Inc., appears only one more time in the record in an incomplete and self-serving document¹² dated November 13, 1986, and entitled "Assignment." The document, which is signed by Andrew DeLillo, Sr., references agreements not in this record; asserts that Vincent's Clam Bar of Mott & Hester Streets, Inc. is the owner of the names "Vincent's Clam Bar of Mott & Hester Streets," "Vincent's Clam Bar," "and any other derivation of the trade name"; and assigns its rights thereto to Vincent's Restaurant Development Corp.

There are two additional documents that are particularly relevant. These are entitled "Purchase Agreement" and "Assignment of Trademarks" and are both dated July 21, 1992. These documents are between

¹² Most of the documents submitted herein include recitations of facts in addition to transferring property. We note, however, that these are agreements between parties and the mere recitation of certain facts does not establish those facts in this proceeding.

applicant as purchaser/assignee and the following
individuals and entities as sellers/assignors:

Andrew DeLillo, Sr.
Andrew DeLillo, Jr.
Vincent DeLillo
Mott & Hester Restaurant Corp. (the debtor in the
aforementioned bankruptcy)
Vincent's Restaurant Development Corp. (a
corporation not previously mentioned)

The Purchase Agreement contains the statement "[i]t is
the intention of this Agreement that any and all rights
transferred to Andrew DeLillo, Sr. pursuant to the terms
of the 1979 Agreement be hereby transferred by him to the
Transferee [applicant] pursuant to the terms of this
Agreement." The Purchase Agreement states, in part, the
following:

1.a.
Simultaneously and with the execution and
delivery of this Agreement the
[sellers/assignees] do hereby convey, sell,
transfer, assign, set over and deliver to
Transferee [applicant], and its successors and
assigns, all of their respective rights
(including the right to sue for past
infringement), title, interests and claims in,
to, relating to or arising under (i) the names
"Vincent's Clam Bar" and "Vincent's Clam Bar of
Mott and Hester Streets," and any all (sic)
variations thereto and derivatives thereof,
together with all trademarks, tradenames,
service marks, copyrights, registrations thereof
and applications for registration therefor ("the
Trademarks"), (ii) the good will associated
therewith ("the Goodwill"), and (iii) the
recipes for the sauce and the shrimpballs
currently being served at Vincent's Clam Bar of
Mott & Hester Streets, 119 Mott Street, New
York, New York and Vincent's Clam Bar of Mott &

Hester Streets, 187 Old Country Road, Carle Place, New York 11514 ("the Recipes"), for the purchase price set forth in Paragraph 2 hereof.

The referenced "Assignment of Trademarks" of the same date references the Purchase Agreement and assigns to applicant the trademarks "Vincent's Clam Bar" and "Vincent's Clam Bar of Mott & Hester Streets," and the appurtenant good will, as well as "any all (sic) variations thereto and derivatives thereof." Neither the Purchase Agreement nor the Assignment of Trademarks references or contains an addendum listing specific marks.

The discovery and testimonial depositions of applicant's president, Anthony Marisi, with respect to various trademark-related facts relevant to ownership and priority, are often contradictory and vague, and, thus, lacking in credibility. In Mr. Marisi's discovery deposition, submitted by opposer, Mr. Marisi appears to possess little information and he stated, essentially, that his attorneys possess most, if not all, of the information regarding applicant's purchase of the Carle Place restaurant and various trademarks, and the use of various trademarks in connection with the restaurant; and that his attorneys handle all of the business in this regard. By the time of his testimonial deposition, Mr.

Marisi appears to have acquired substantial knowledge relevant to the trademark issues of ownership and priority. These inconsistencies raise questions about the credibility of Mr. Marisi's statements in his two depositions. However, even if we accept Mr. Marisi's testimony statements at face value, Mr. Marisi lacks clear personal recollection, or recollection based on specific business records, about a number of relevant facts.

Mr. Marisi's two depositions do provide some uncontradicted information about applicant, Quadami, Inc. Mr. Marisi testified that applicant was incorporated in 1983; that Mr. Marisi and his brother, Robert, are now equal co-owners of the shares of the corporation; and that applicant owns a single restaurant, Vincent's Clam Bar, in Carle Place, New York, and no other businesses.¹³ Mr. Marisi testified that he worked in the Carle Place restaurant as a waiter from approximately 1979 to 1983, when applicant purchased the restaurant; and that since at least 1979, the Carle Place restaurant has been identified as "Vincent's Clam Bar." The advertisement shown below for the Carle Place restaurant appeared in a

¹³ Applicant's principals are involved in other businesses and applicant is part of a joint venture that operates another restaurant.

December 1983 *Long Island NightLife* magazine, while the restaurant was still owned by DeLillo.



Due to inconsistencies between Mr. Marisi's two depositions regarding the nature, and dates, of use of various marks, we have relied on certain testimony by Mr. Marisi only when corroborated by documentary evidence. In his testimonial deposition, Mr. Marisi stated that the same logo had been used by the Carle Place restaurant since at least 1979; and that this logo, with the street sign design, has been used by applicant since 1983 on numerous collateral items, including menus, T-shirts, place mats and matchbooks. However, in his discovery deposition, Mr. Marisi stated that applicant began use of this mark a full ten years later, in 1993. There is no other documentary evidence corroborating applicant's date of first use of this mark or whether use of this mark has

been continuous since at least 1983 when it appeared in the magazine noted above.

Mr. Marisi testified, again without documentary corroboration regarding the dates, that applicant used the following design¹⁴ on its take-out menu beginning some time between 1983 and 1990:



Mr. Marisi stated that Vincent DeLillo was his employer during his years as a waiter at the Carle Place restaurant; and that applicant purchased from the DeLillos the franchise/license agreement for the Carle Place restaurant and, subsequently, "the trademarks." Mr. Marisi stated that he never met the Sianos, the original owners of the Mott Street restaurant; that all of applicant's franchise business dealings were with the

¹⁴ This is almost identical to the design used by opposers in their 1985-1986 and 1994 menus, and, originally, by the Sianos.

DeLillos; and that he has no personal knowledge regarding the Sianos' use of their marks in connection with the Mott Street restaurant.

The record regarding applicant raises additional credibility questions for applicant. First, the specimen of record in application Serial No. 74/358,685 (THE ORIGINAL VINCENTS ESTABLISHED 1904 and design) is opposers', rather than applicant's, business card. Although applicant's verification in the application, signed by Anthony Marisi, affirms that this business card specimen evidences applicant's use of the mark shown below,



in his testimony, Anthony Marisi admitted that the specimen belonged to opposer, not applicant, and offered no explanation for the incorrect specimen or the false statement in the verification. The record contains no evidence of any use of this particular design mark by applicant in connection with its restaurant services.

Second, a written statement by Robert Marisi, Anthony Marisi's brother, submitted in connection with

the same application and properly submitted into evidence herein, states that opposers are the licensees of applicant; and that the use by opposers of their marks inures to applicant's benefit. The record establishes, and Anthony Marisi admitted in his testimony, that no such relationship exists; that applicant was aware of opposers' right to use the marks listed under the bankruptcy stipulation; that applicant took no action in relation to opposers' restaurant that would indicate a belief that a license relationship existed between the parties; and that, in fact, the principals involved herein did not meet or otherwise have any contact prior to this Board proceeding.¹⁵

¹⁵ Applicant also, in signing the declarations in the applications involved in this proceeding, stated that "to the best of his knowledge and belief, no other person, firm, corporation or association has the right to use the above-identified mark in commerce" Clearly, applicant has always been aware of opposers' right to use the marks recited in the stipulation and, therefore, this statement in each declaration is false. Should applicant ultimately prevail in this opposition proceeding, both applications shall be remanded, under Trademark Rule 2.131, for reexamination of applicant's specimen in application Serial No. 74/358,685 and the false statements made in connection therewith, and the false statements made in both applications that applicant believes no other entity has the right to use these marks. We note the dissent's comment that Office policy forbids Examining Attorneys from issuing actions relating to allegedly fraudulent statements made by an applicant. Generally, Examining Attorneys do not have the evidence to determine, in an ex parte context, questions relating to fraud. However, in the present case the parties have been involved in an inter partes proceeding in which evidence indicating fraud has been adduced. (The dissent's suggestion that applicant's claim of use of the mark based on opposers' use, and the submission of opposers' business card as a specimen, was due to applicant's mistaken belief that opposers' use inured to applicant's

Finally, regarding the mark in application Serial No. 74/358,686 (VINCENT'S CLAM BAR and street sign design), in his discovery deposition Mr. Marisi stated that he has no recollection of how this particular mark was developed; whereas in his testimony deposition he indicated that this was the same mark used by the DeLillos, which was part of the sale of trademarks from the DeLillos to applicant. The documentary evidence, including applicant's assumed name filing and various applications for liquor licenses from 1983 to the present, all show applicant as "Quadami, Inc. d/b/a Vincent's Clam Bar."

Both parties have been aware of the other's restaurant since first obtaining their interests in their respective restaurants and the marks. Mr. Marisi stated that customers have asked if the Carle Place restaurant is related to the Mott Street restaurant. He also specifically acknowledged that applicant benefits from opposers' advertising; and that applicant uses its marks in a manner to suggest and emphasize a connection with the current Mott Street restaurant. In this regard, Mr.

benefit because opposers were applicant's licensees, is belied by the evidence.)

Marisi indicated that the original Mott Street restaurant was applicant's, as well as opposers', origin.

Parties' Arguments

We begin with a brief recitation of the significant arguments made by the parties in their briefs.

Opposers contend that they have established standing; that they have priority of use; and that applicant's testimony contains false statements and inconsistencies regarding its use of its marks which preclude its reliance on dates of use earlier than its filing date of February 11, 1993 in both applications. Opposers also contend that applicant may not rely on its alleged use of the marks when it was a licensee because such use inures to the benefit of the owners of the mark; and that applicant also may not rely on use by the "purported assignors" of the marks to applicant because these assignors lacked ownership of the marks, *i.e.*, the chain of title to applicant has not been established. Opposers contend that the Bankruptcy Court stipulation contains inconsistencies that render it a naked license to applicant's predecessors to use the referenced trademarks; and that such a naked license is "a break in the chain of continuous use by applicant's purported assignors."

Opposers contend that both of applicant's marks are substantially similar to opposers' marks, stating that

the mark THE ORIGINAL VINCENT'S ESTABLISHED 1904 and the specific design in application Serial No. 74/358,685 is identical to opposers' mark, noting in particular that applicant's supporting specimens consist of opposers' business card and actually evidence opposers' use of its mark. Opposers state, further, that the design mark in application Serial No. 74/358,686 (VINCENT'S CLAM BAR and street sign design) is substantially similar to opposers' mark, noting in particular the similarity of script and words used and the design of the street sign.

Opposers state that the parties' services, restaurant services, are identical and that, in fact, both parties operate Italian restaurants specializing in seafood and which are located in the metropolitan New York area. Additionally, opposers contend that significant actual confusion as to the sources of the two restaurant services exists among consumers.

In its brief, applicant states that "[t]he central (if only) legal issue in this case is priority of rights." Applicant acknowledges that the issue is not actually likelihood of confusion. Applicant essentially concedes that the marks are substantially similar because both parties' marks are derived from the original use of substantially similar marks by the Siano family at the

Mott Street restaurant; and that the parties' respective rights in these marks are defined by the 1985 bankruptcy stipulation.

Applicant argues that the appropriate question is who is the legal owner of these marks. Applicant contends that it has established that it purchased the Vincent's Clam Bar restaurant business, the goodwill thereof and its related trademarks. Applicant focuses on the bankruptcy stipulation and contends that it establishes Andrew DeLillo's ownership of the Vincent's Clam Bar trademarks at the time of the stipulation so that any prior inconsistencies in title are irrelevant. Applicant contends that opposers are also bound by the bankruptcy decree, which allegedly gives them no ownership rights in the claimed trademarks; that applicant was properly assigned the trademarks by Andrew DeLillo; and that, therefore, applicant is the owner of the trademarks in the two applications and prior use of the trademarks by DeLillo inures to applicant's benefit.

Applicant contends that opposers cannot claim that the Siano family's use of the marks inures to their benefit; that opposers are estopped from challenging these applications because the bankruptcy stipulation expressly states that opposers have no ownership rights

in the marks herein and geographically restricts their use of these marks; and that, in view of the terms of the bankruptcy stipulation, opposers' use inures to applicant's benefit so that applicant's misrepresentations in its application are insignificant.

Analysis

First, we conclude that opposers have established their standing in this proceeding. Even though they are not owners, opposers have clearly demonstrated, by the terms of the bankruptcy stipulation, their right to use the marks VINCENT'S CLAM BAR, VINCENT'S CLAM BAR OF MOTT AND HESTER STREETS and MOTT AND HESTER RESTAURANT and, thus, their interest in the registrability of the marks in these applications.¹⁶

This is an unusual case because the parties derive their rights from the same restaurant, VINCENT'S CLAM

¹⁶ Opposers have established that they have a real interest in this proceeding and, therefore, they have established their standing to pursue the opposition. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). This is so even if opposers are not owners of the pleaded marks, for a plaintiff may have standing and may succeed in a case brought under Section 2(d) of the Trademark Act even if it does not claim ownership of the assertedly similar mark, or the right to control its use. See *J.L. Prescott Co. v. Blue Cross Laboratories (Inc.)*, 216 USPQ 1127 (TTAB 1982) (opposer that had assigned mark and obtained exclusive license from assignee held to have standing); See also, *Universal Oil Products Co. v. Rexall Drug and Chemical Co.*, 463 F.2d 1122, 174 USPQ 458 (CCPA 1972); *BRT Holdings Inc. v. Homeway Inc.*, 4 USPQ2d 1952 (TTAB 1987); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139 (TTAB 1986); and *Yasutomo & Co. v. Commercial Ball Pen Co., Inc.*, 184 USPQ 60 (TTAB 1974).

BAR, established by the Siano family at 119 Mott Street. As a result, both parties are using essentially the same or substantially similar marks in connection with their respective and identical restaurant services and actual confusion has occurred. Applicant concedes as much. Thus, there is no question that a likelihood of confusion exists.

Ordinarily, having found that a likelihood of confusion exists, we would resolve the case by determining which party has priority of use. However, that is not a simple task in this case, because both parties trace their rights to the same 1985 bankruptcy stipulation; and both parties' rights in the mark VINCENT'S CLAM BAR stem from the use of that mark by the Siano family beginning in 1904. Further, the marks at issue in this proceeding are not identical to the marks identified in the bankruptcy stipulation. Thus, we must evaluate the nature of the respective rights of the parties.

Ownership of the Siano family's restaurant was transferred to Andrew DeLillo and/or his corporate interests ("DeLillo") in 1979. DeLillo continued to operate VINCENT'S CLAM BAR at 119 Mott Street and opened

several additional restaurants also named VINCENT'S CLAM BAR.

The next change in ownership of the Mott Street restaurant, but not of DeLillo's other restaurants with the same name, occurred as a result of the 1985 bankruptcy stipulation entered by the bankruptcy court.

However, the 1985 stipulation created a difficult situation from the perspective of trademark law. First, it resulted in at least two unrelated restaurants using the identical name and operating in the New York metropolitan area. Second, the stipulation granted Andrew DeLillo "sole" ownership of, and the "sole and exclusive right to use," the trademarks VINCENT'S CLAM BAR, VINCENT'S CLAM BAR OF MOTT AND HESTER STREETS and MOTT AND HESTER RESTAURANT¹⁷; yet it also granted the

¹⁷ Section 1.E. of the bankruptcy stipulation states, essentially, that the purchasers of the Mott Street restaurant acknowledge Andrew DeLillo's sole ownership of these three marks, but did not include specific reference to "facsimile[s]" of these three stated marks. Contrary to the statement by the dissent, the term "facsimile" is not used in that section of the stipulation. Rather, it is used in Section 1.D. of the bankruptcy stipulation wherein purchasers (opposers' predecessors) agree, *inter alia*, not to represent that they have an affiliation with "any other business" using any of the three previously-stated marks "or any facsimile thereof." Clearly, the purpose of this statement is to prevent purchasers from trading on the reputation built up by other restaurants owned by DeLillo or his successors, which would include prohibiting opposers' predecessors from using or copying facsimiles of the three named marks to indicate such an affiliation. We do not find it appropriate to read the term "facsimile[s] thereof" into paragraph 1.E. of the stipulation. There is nothing in the language of the stipulation from which we can conclude that the intent of the stipulation was to grant Andrew DeLillo blanket ownership rights from that date in any "facsimile" of the three named marks, regardless of

purchasers of the Mott Street restaurant (opposers' predecessors) the right to continue to use the same trademarks, without any time limitations, although only at the 119 Mott Street location. Opposers' predecessors' right to use these three marks was created by the stipulation and it is neither a license, a franchise nor an ownership right.

The bankruptcy stipulation was not drafted to conform to generally accepted trademark principles and both the majority and the dissent herein have struggled to interpret this document, which is far from clear. In order to give effect to this court-ordered stipulation, which we must, we look to the surrounding circumstances. Clearly, one purpose of the stipulation, as it pertains to the purchasers of the Mott Street restaurant, was to permit the purchasers to continue to operate and identify the restaurant as it was operated and identified prior to their purchase. The stipulation implicitly recognizes that a significant value of the restaurant purchase is the good will built up in the trademarks that had been used in connection therewith by the prior owners. As we

whether the mark is materially the same as one of the three named marks or was in use at the time of the stipulation. At most, this language indicates that Andrew DeLillo might use facsimile marks and such use was not prohibited.

have already stated, opposers are bound by this stipulation, as were their predecessors.¹⁸

We find that applicant, through documentation, has established its ownership of the Carle Place restaurant and that it is the successor in interest to any trademarks that DeLillo owned in connection therewith.¹⁹ As a successor to DeLillo, applicant is also bound by the bankruptcy stipulation and must recognize opposers' separate right to use the marks identified in the stipulation at the Mott Street location. Opposers have no relationship, such as licensee, to applicant, and

¹⁸ We do not find opposers' attacks on the validity of the bankruptcy stipulation to be persuasive. The court ordered stipulation is essentially an enforceable contract between the parties, and their successors. As the court concluded in *Times Mirror Magazines Inc. v. Field & Stream Licenses Co.*, 63 USPQ2d 1417 (CA 2 2002), simple fairness requires holding a party to its contract unless adhering to the contract would damage the public and not just a contracting party. If members of the public, as a result of confusion, buy services of equal quality that do not threaten their health and safety, significant harm results only to a contracting party. In the absence of significant harm to the public, the court is correct in declining to don the mantle of public interest to save plaintiff from a harm that is permitted by the contract. Any application for relief from the terms of the stipulation must be made to the court that entered the stipulation.

¹⁹ Despite opposers' contentions to the contrary and the many incomplete or questionably related legal agreements, licenses, assignments, etc. in the record, applicant has provided sufficient documentary evidence to establish that it obtained, through the 1992 purchase and sale agreement and the assignment of trademarks, rights in all relevant trademarks owned by the DeLillos and their related companies. Any breaks in the chain of title of the marks VINCENT'S CLAM BAR, VINCENT'S CLAM BAR OF MOTT AND HESTER STREETS, and MOTT AND HESTER RESTAURANT prior to the bankruptcy stipulation are rendered irrelevant by the bankruptcy stipulation, which establishes DeLillo's ownership of these particular marks. All of the individuals and companies recited in relevant documents subsequent to the bankruptcy stipulation participated in the 1992 assignment to applicant.

opposers' use of marks identifying the Mott Street restaurant does not inure to applicant's benefit.

The bankruptcy stipulation refers to three specific marks. A problem that the stipulation does not anticipate is the fact that the marks used by both parties have evolved over time. Opposers made changes to the marks referenced in the stipulation and began using variations thereof. The mark identifying opposers' restaurant evolved from VINCENT'S CLAM BAR to THE ORIGINAL VINCENT'S CLAM BAR, and, finally, to THE ORIGINAL VINCENT'S ESTABLISHED 1904. It is this mark that opposers have continued to use.

The question that arises at this point is whether opposers are permitted under the bankruptcy stipulation to use this variation of the marks listed in the stipulation. Section 1.D. of the bankruptcy stipulation includes the statement that "... [purchasers] shall use and operate their business at the aforementioned premises [119 Mott Street] under the name of "Vincent's Clam Bar," and/or "Vincent's Clam Bar of Mott and Hester Streets," or "Mott and Hester Restaurant," and only at said location without limitation of time and at no other location" This statement must be understood in the context of the entire paragraph. The intent of the

section is clearly to allow the purchasers of the Mott Street restaurant (opposers' predecessors) to continue to use the names that have been used for that restaurant, but to draw boundaries around that use to prevent the purchasers of the Mott Street restaurant from using those marks, or any facsimiles thereof, in any manner that would expressly or implicitly indicate any affiliation with, or connection to, the remaining restaurants owned by DeLillo using those same three trademarks.²⁰

With this context in mind, we do not find the language of the stipulation to expressly or implicitly prohibit any variation on the three specified marks by purchasers, as long as opposers are not representing themselves as being affiliated with DeLillo's restaurants. Certainly, looking at the particular changes made by opposers, the deletion of the generic term CLAM BAR cannot even be considered as a real change to the mark, as it has no source identifying significance. Further, considering, again, the context

²⁰ The dissent makes the point that it is applicant, as the owner of the marks, which has the prerogative to adopt a mark similar to one it already owns. While it is generally (but not always) true that a trademark owner has this right, here we are not dealing with a typical trademark situation, but one in which general trademark principles have been turned on their heads by the bankruptcy stipulation. Applicant does not have the right to adopt variations of its marks that are designed to cause confusion. From Mr. Marisi's testimony, it appears that applicant has very deliberately copied opposers' manner of use of its marks and its advertising so as to cause confusion as to source.

in which this stipulation was concluded, *i.e.*, two unrelated restaurants identified by the same name were operating in the New York metropolitan area, it is an equitable reading of the stipulation to allow opposers to make the minor changes of adding THE ORIGINAL, which accurately describes the restaurant, and the date the restaurant was established to the marks used in connection with the Mott Street restaurant. This is particularly true where, as in this case, the purpose of opposers' changes was to avoid confusion with the Carle Place restaurant.²¹ Thus, we interpret the bankruptcy stipulation as allowing opposers the right to use the mark, THE ORIGINAL VINCENT'S ESTABLISHED 1904, but, consistent with the stipulation, not giving opposers ownership rights in that mark.²²

²¹ Mr. Generoso stated that he was concerned about consumer confusion regarding the perceived relationship between the Mott Street restaurant and the Carle Place restaurant, so he added the term "THE ORIGINAL" to "VINCENT'S CLAM BAR" because the Mott Street location was the original restaurant location. Then he eventually dropped the "CLAM BAR" portion of the mark because he believed the term was outdated and limiting, because the restaurant offered all types of seafood.

²² The dissent asks the question of how can a mark which opposers have used for many years have no owner. The blame must be placed on the bankruptcy stipulation which, as noted previously, was not drafted to conform to general trademark principles, and has resulted in a number of anomalies.

Although opposers do not own this mark,²³ their court-ordered right to use the mark gives them a valid basis to object to applicant's obtaining a geographically unlimited registration, that does not contain an exception for opposers' right to use, for the identical mark, in application Serial No. 74/358,685, including the design elements thereof, for the identical services.²⁴

Opposers have established their use of the mark THE ORIGINAL VINCENT'S ESTABLISHED 1904 since approximately 1985-1986, and certainly by 1989, and applicant has established no use of this mark by itself or its predecessors, let alone any use prior to opposers' use.²⁵

²³ There is no requirement that an opposer own or use the mark in order to prevent another party from using the mark. See *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). Opposers have more than adequately established that they are not mere intermeddlers and they have sound reason for fearing damage to themselves if applicant's mark were registered. See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). See also ftn. 16.

²⁴ However, this is not a concurrent use proceeding and, further, we are not suggesting by this statement that opposers would be entitled to a registration, limited or unlimited.

²⁵ The 1992 assignment from DeLillo transfers to applicant ownership of two of the marks recited in the bankruptcy stipulation, VINCENT'S CLAM BAR and VINCENT'S CLAM BAR OF MOTT & HESTER STREETS, and "any all (*sic*) variations thereto and derivatives thereof." However, applicant can obtain ownership *through the assignment* only of those variations or derivatives that applicant's predecessors actually used in connection with their restaurant services. There is no evidence that applicant's predecessors used the mark THE ORIGINAL VINCENT'S ESTABLISHED 1904. There is, likewise, no documentary evidence or clear, uncontradictory testimony that applicant has ever used this mark. Thus, while an applicant in an opposition proceeding is not required to prove use in order to prevail, without evidence of earlier use, an applicant is

Because, in the absence of evidence of actual use, applicant is limited to its filing date in this case, opposers have clearly shown priority.

Further, because opposers have established that they use the identical mark in connection with the identical services recited in application Serial No. 74/358,685, we conclude that opposers have established that there is a likelihood of confusion because applicant knew of opposers' use of the identical mark and deliberately adopted the mark of opposers and applied to register that mark. Moreover, it is clear that applicant intended to cause confusion by, knowing of opposers' use of the identical mark, deliberately adopting the mark of opposers and applying to register that mark.

The factual situation is different with respect to the mark in application Serial No. 74/358,686, VINCENT'S CLAM BAR and street sign design.²⁶ The record shows this design being used, first, by the Sianos, then by

limited to the application's filing date. *Columbian Steel Tank Company v. Union Tank and Supply Company*, 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960) ("Appellee's application alleges February 1, 1946 as the date of first use of its mark but in the absence of testimony appellee must be restricted to its filing date of June 29, 1956, as the board correctly held").

²⁶ The record indicates that opposers stopped using their mark with a similar street sign design after 1989. Therefore, we consider whether confusion is likely between the street sign design mark in this application and opposers' mark THE ORIGINAL VINCENT'S ESTABLISHED 1904.

applicant's predecessor, DeLillo, in a 1983 advertisement, and applicant currently uses this mark. Applicant originally claimed 1992 as its date of first use of this mark and later amended that date to a date subsequent to the filing date.²⁷ However, as with the mark considered above, we have treated the filing date of the application, February 11, 1993, as applicant's date of first use of this mark. To establish an earlier date of first use, applicant must do so through clear and convincing evidence, which it did not do. There is no documentary evidence and only vague and conflicting testimony as to whether DeLillo continued to use the mark or the length of applicant's use of this mark. All we can tell from this record is that the mark is currently in use. Because of the inconsistency between the claimed use dates in the application and the evidence of a single 1983 use by DeLillo, it appears that this mark may have been abandoned by DeLillo. As previously stated, opposers have been using the mark THE ORIGINAL VINCENT'S ESTABLISHED 1904 since approximately 1985-1986, or at least since 1989, and clearly have priority.

We also find that applicant's mark is substantially similar in appearance, connotation and commercial

²⁷ See footnote 2, *supra*, regarding applicant's amendment to its dates

impression to the mark THE ORIGINAL VINCENT'S ESTABLISHED 1904 used by opposers, and applicant does not argue otherwise. Both marks contain the name VINCENT'S in the same script, which is more prominent than the other smaller and merely descriptive wording in the marks, and, thus, it is the dominant portion of both marks.

Moreover, both parties concede that there has been actual confusion. In view of the similarities in the marks, there is a likelihood of confusion as to the source of the parties' identical services identified thereby. Applicant is not entitled, in this application, to a geographically unlimited registration that does not contain an exception for opposers' right to use.

Decision: The opposition is sustained and registration is refused in each application. We reiterate that, should applicant ultimately prevail in this opposition proceeding, both applications shall be remanded, under Trademark Rule 2.131, for reexamination of applicant's specimen in application Serial No.74/358,685 and the statements of use made in connection therewith; for reexamination of the asserted dates of use in application Serial No. 74/358,686; and, for both applications, for consideration of the false

of use in this application.

statements made in the declarations that applicant believes no other entity has the right to use these marks and statements made during prosecution of application Serial No. 74/358,685. See in this connection, footnotes 2 and 15.

Simms, Administrative Trademark Judge, dissenting:

Because I believe that opposers do not have the right to prevent applicant from registering its marks, I would dismiss this opposition.

The 1985 bankruptcy stipulation (hereafter, "consent decree"), which was signed on behalf of opposer Vincent Generoso and his partners, is binding on the parties to this case. This consent decree is the governing document which determines the outcome of this opposition proceeding. *W.L. Gore & Associates, Inc. v. C.R. Bard, Inc.*, 977 F.2d 558, 24 USPQ2d 1451, 1453 (Fed. Cir. 1992)("[T]he consent order embodying the settlement between...is a final judgment; it is accompanied by finality as stark as an adjudication after full trial.")

That decree not only transferred the restaurant facility now operated by opposers but also resolved or settled the rights in the marks set forth in the decree. The relevant provisions are again set forth below:

1.D.

... purchasers [opposers] do not and will not have, nor represent itself to have, any affiliations or connection with any other business known as VINCENT'S CLAM BAR, VINCENT'S CLAM BAR OF MOTT & HESTER STREETS, or MOTT & HESTER RESTAURANT, or any facsimile thereof, and will remove any reference thereof from menus, signs, logos, advertisements... and the purchasers further agree that they will not, in any way, represent that they are affiliated with any other business licensee or franchisee using said name or names or facsimile thereof and that they shall use and operate their business at the aforementioned premises under the name of VINCENT'S CLAM BAR, and/or VINCENT'S CLAM BAR OF MOTT & HESTER STREETS, and/or MOTT & HESTER RESTAURANT, and only at said location without limitation of time and at no other location... and the parties hereby agree that ... the purchasers are not successors in interest, licensees, franchisees and/or affiliated with Mott & Hester ...

1.E.

Upon information and belief... purchasers hereby acknowledge and agree, subject to the terms of paragraph "1.D." herein, that ANDREW DELILLO is the sole owner of and has the sole and exclusive right to use the name, trademark and copyrights in and to the names VINCENT'S CLAM BAR, VINCENT'S CLAM BAR OF MOTT & HESTER STREETS, and MOTT & HESTER RESTAURANT, and nothing contained herein shall be deemed a sale thereof nor shall in any way restrict or interfere with said right and interest or his right to use, convey, sell, license, franchise or in

any other way dispose of or make use of
said names ...

As can be seen, opposers took ownership of the restaurant building and were allowed to use the marks specified in the decree, including VINCENT'S CLAM BAR. The consent decree states explicitly that "[opposers] shall use and operate their business at the aforementioned premises under the name of VINCENT'S CLAM BAR, and/or VINCENT'S CLAM BAR OF MOTT & HESTER STREETS, and/or MOTT & HESTER RESTAURANT, and only at said location... and at no other location...". In the decree, opposers agreed that Andrew DeLillo was the sole owner of the marks mentioned and that opposers would not claim rights as the successors to the original restaurant, or claim to be affiliated in any way with the owner of the marks. Andrew DeLillo was also implicitly allowed to use "facsimile[s]" of the marks.²⁸

²⁸Mr. Generoso acknowledged (dep., 14) that the consent decree authorized him and his company to use only the marks in the consent decree:

- Q. Did you understand that you could only use those three names or did you understand that you had a right to use other names?
A. Only those names.

However, Mr. Generoso apparently was not aware that applicant's predecessor, Mr. DeLillo, retained any rights in the marks opposers were allowed to use. At 135, Mr. Generoso testified:

- Q. Did you have an understanding that Mr. DeLillo retained the right to the name Vincent's Clam Bar, Vincent's of Mott and

Then, in 1992, five parties, including Mr. DeLillo and Vincent's Restaurant Development Corporation (which was assigned certain rights in the marks in November 1986), joined in assigning a restaurant business, including whatever rights they had in the marks and "any [and] all variations thereto and derivatives thereof," to applicant. In other words, the acknowledged owner of the marks in the 1985 consent decree transferred title in the marks as well as the goodwill to applicant.

Opposers' arguments in their reply brief that they are somehow not bound by the language of the consent decree or that subsequent information revealed that Andrew DeLillo was not the owner of the marks in 1985 can be given no weight. The decree must be construed as giving opposers ownership of the restaurant facility on Mott Street as well as the unlicensed right to use the marks in the decree, and that the ownership of those marks resides in Mr. DeLillo, and now in his successor, applicant.

Hester Streets or Mott and Hester
Restaurant?

A. No.

Q. You had no understanding that he retained those rights at the time he purchased this restaurant?

A. No.

Applicant here seeks registration of two marks, one of which is dominated by the words VINCENT'S CLAM BAR and the other being THE ORIGINAL VINCENT'S ESTABLISHED 1904. As the owner of the mark VINCENT'S CLAM BAR, applicant clearly has the right to register this mark as against opposers, who only have an unlicensed right to use this mark (and they admittedly no longer use the mark VINCENT'S CLAM BAR). In addition, opposers stopped using the only other element in the mark presented in Serial No. 74/358,686--the street sign design--in 1989. Because applicant is the successor to the acknowledged owner of the VINCENT'S CLAM BAR mark, it is clear, therefore, that applicant has the right to register the mark in this application. We are left with the mark THE ORIGINAL VINCENT'S ESTABLISHED 1904, a mark not mentioned in the consent decree.

Because applicant's predecessor was acknowledged to be the owner of the marks in the decree and their facsimiles, it was only the predecessor or applicant as successor to the owner who could change those marks. Only applicant (or its predecessor), and not opposers, could subsequently adopt a mark which was "confusingly similar" to any mark which applicant already owned. Certainly, opposers were not authorized by the consent

decree to change their marks and to adopt another mark which was likely to cause confusion with one of the marks owned by applicant.

Yet, the majority claims that opposers had the right to change the marks under the consent decree. The majority states that elimination of the words "Clam Bar" was no "real change" in the mark because it deleted only generic matter, and notes that the addition of the words "The Original" to the mark was done to avoid confusion. The majority, nevertheless, finds that this attempt was unsuccessful since the revised mark and both of applicant's marks are still likely to cause confusion.

According to the majority, opposers can change the marks specifically mentioned in the consent decree, but opposers' revised mark, THE ORIGINAL VINCENT'S ESTABLISHED 1904, which they adopted and began using as early as 1989, is, according to the majority, not owned by opposers. In other words, the mark which opposers adopted and assert in this proceeding has no owner. It was apparently born an orphan and will always remain so. One might reasonably ask: How can a mark which opposers created and used for their restaurant services for a number of years, or for that matter, any mark, have no owner? To me, the majority reaches this illogical and

untenable legal conclusion of a mark without an owner because of a misconstruction of the consent decree. We do not know the reason or reasons why the consent decree was drafted the way it was, but it is our duty to respect it and to interpret it so as to give effect to its provisions. In my view, opposers have the right to use only those marks specified in the consent decree. By stipulating that Mr. DeLillo was the owner of the marks (and facsimiles) and by indicating that opposers only had the unlicensed right to use the marks, the decree should be interpreted in a manner consistent with these provisions. That is to say, opposers, who lack ownership of the marks, cannot use marks other than those specified in the consent decree. If any party is allowed to alter its marks, it must be the owner thereof, which has the prerogative, as any owner does, to adopt a mark which may be very similar to those which it already owns, and not the party who was only given the right to use certain specified marks at a single restaurant location.

This fact may be illustrated in the following hypothetical. If the 1985 decree had indicated not only that applicant (or its predecessor) was the owner of the marks, but also that opposers were *authorized licensees* of those marks, it would be clear, under traditional

licensing arrangements, that opposers, as licensees, could not change the licensed marks without the approval of the licensor/owner. Certainly an unlicensed, naked user who has admittedly only an uncontrolled right to use (opposers' brief, 35, 36) should have no more rights to alter or change a mark that it is allowed to use than a licensed user would have. Even opposers state in their reply brief (14-15), in referring to *applicant's* changed marks, that "there is no factual or legal basis to conclude that 'The Original Vincent's Established 1904' is a facsimile of the subject names." But this argument applies with even greater force to opposers' revised mark. Opposers should not be heard to complain that applicant, the owner of the marks in the decree, may not use and seek registration of any marks somewhat different from those conceded to be owned by Mr. DeLillo in 1985, and now owned by his successor.

As can be seen, opposers have very limited rights under the consent decree, while applicant, as a successor-in-interest, has complete ownership. If the issue in this opposition is one of priority or superior rights,²⁹ there can be little question but that it is

²⁹ Opposers have only pleaded priority and likelihood of confusion as their grounds for opposition. The issue of abandonment, which may theoretically be raised as a result of the unlicensed use permitted by

applicant who has superior rights in the marks and in similar marks. Applicant should be free to use and register its marks, especially in a contest with a party which has admittedly only an uncontrolled, naked right to use certain marks. Opposers with their limited rights have no right to prevent or interfere with applicant's right to protect its marks by registering them and thereby giving notice to others of its ownership in these marks. Indeed, the decree specifically indicates that nothing in the decree "shall in any way restrict or interfere with" applicant's right to sell, license or franchise its marks. Certainly, the denial of registration to applicant will substantially interfere with the right to sell or license the marks, in violation of the decree, because the lack of registration will make the purchase price or the licensing of the marks to others substantially less valuable. The majority's interpretation of the consent decree, therefore, interferes with the rights to sell, license and franchise the marks.

the consent decree, was neither pleaded nor tried as a ground for opposition. Therefore, we should not consider this issue in resolving this opposition. Opposers' arguments in its briefs about applicant's or its predecessors' rights in the marks being separated from any underlying goodwill cannot, therefore, be considered. In any event, it appears from this record that, after 1985, Mr. DeLillo continued to

It is also better public policy for the register to reflect applicant's ownership of its marks. As between these parties, applicant has the superior claim to the trademarks sought to be registered. It is not seen how a mere user (of marks not mentioned in the consent decree) at a single restaurant in New York City should be able to prevent the owner of the mark from registering its mark on a nationwide basis, as notice to all of its claim of rights.

The majority's suggestion that the parties should seek concurrent use registrations is also not tenable. Only the owner of a mark may seek a concurrent use registration. See Section 1(a)(1) ("The owner of a trademark used in commerce..."); Trademark Rules 2.42, 2.33(b)(1) ("In an application under section 1(a) of the Act, the verified statement must allege... that the applicant believes it is the owner of the mark...") and 2.99; TBMP §§1102.02 and 1102.02(a)(3). The majority has stated, however, that opposers do not own the mark they now use and assert herein. Also, because opposers' mark is not one covered by the consent decree, that decree, which does not in any event order this office to grant concurrent use registrations, cannot be a basis for

operate a restaurant outside Manhattan under the name Vincent's Clam Bar

granting concurrent use registrations to either party. Moreover, while the majority suggests that applicant's rights are geographically limited in nature, a careful reading of the consent decree reveals that DeLillo (and now applicant) only agreed (in 1985) not to compete with opposers within a ten-block radius of opposers' facility only for the length of opposers' mortgage. Thereafter, it appears that applicant could open a restaurant even in that ten-block area. So applicant's rights are only geographically limited for a certain period of time, which time period may already have expired. In any event, the only question in this proceeding is whether applicant is entitled to an unrestricted registration,³⁰ and opposers have not requested or asserted that applicant's registrations should be limited in some manner, only that registration to applicant be refused because of opposers' rights in their asserted mark. See *U.S. Soil, Inc. v. Colovic*, 214 USPQ 471 (TTAB 1982). That is, opposers have not "object[ed] to applicant's obtaining a geographically unlimited registration, that does not contain an exception for opposers right to use,"

or names similar to that one.

³⁰ Trademark Rule 2.133(c) makes clear that geographic limitations in applications will be considered only in the context of concurrent use proceedings.

as the majority has stated. Moreover, opposers may operate their restaurant under the names mentioned in the decree at only the single location on Mott Street, and at no other location. In other words, opposers may not expand their use of these marks.

Furthermore, this is an opposition proceeding where opposers have the burden of proof to establish their superior rights by a preponderance of the evidence. This is not a concurrent use proceeding whereby the respective rights of the parties may be determined in the context of concurrent registrations. That is, we do not have before us either applicant's right to register its marks on a geographically limited basis or opposers' attempt to seek registration for its geographically limited right to use their marks. Compare, for example, *Weiner King, Inc. v. The Weiner King Corporation*, 615 F.2d 512, 204 USPQ820 (CCPA 1980). Nor will any registration to applicant affect opposers' continuing right to use those marks set forth in the consent decree. Applicant has conceded as much in its brief, 21 ("...registration will not affect...the extraordinarily limited rights Opposers have under the Consent Decree."). If opposers are unhappy with their rights under the consent decree, their remedy is to seek modification in the bankruptcy court.

Finally, while I agree that applicant's applications should be remanded for the submission of appropriate specimens,³¹ and to correct allegations of use, Office policy forbids Examining Attorneys from issuing actions relating to any allegedly fraudulent statements made by an applicant. See TMEP § 719 ("Under no circumstances should any Office communication pertaining to fraud be made, either orally or in writing, by anyone in the Trademark Examining Operation...").³² Even in the absence of that clear Office policy, the Board should not place the Examining Attorney in the unenviable position of determining, in an ex parte context, whether certain statements made by applicant were or were not false or fraudulent. Here, applicant has conceded that it made the mistake of submitting as specimens what it thought were examples of use from a licensee. As it turned out, the "licensee" (opposers) was not an authorized licensee but only an entity which was permitted to use the marks pursuant to the consent decree.

³¹In its brief, at 20, applicant states that it "is fully able to provide substitute specimens along with an affidavit or declaration verifying that the substitute specimens were in use prior to the filing date of the application."

³²These issues are handled by the USPTO's Office of Enrollment and Discipline.